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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/422,565 | 10/21/1999 | MEGUMI YOSHIDA | 35.G2473 | 5702 |

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NEW YORK, NY 10112

EXAMINER

TRAN, MYLINH T

| ART UNIT | PAPER NUMBER |
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2179

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/422,565

Applicant(s)

MEGUMI YOSHIDA

Examiner

Mylinh T Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed 07/15/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's Amendment filed 07/15/04 has been entered and carefully considered. Claims 1, 20, 41 and 43 have been amended. However, imitations of amended claims have not been found to be patentable over prior art of record, therefore, claims 1-43 are rejected under the same ground of rejection as set forth in the Office Action mailed (04/21/04).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6, 9, 10, 20, 21, 25, 28, 29, 41, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Word 2000.

As to claim 1, 20, 41 and 43, Microsoft Word 2000 discloses displaying a list including a plurality of registered character strings on a display screen (figure 1, Auto Correct box); user selecting, based on a user instruction (figure 1a), one of the character string included in the list displayed in said step displaying step; and inserting the character string selected in said selecting step at a position pointed by a cursor being displayed on the display screen when the character string has been selected in the selecting step wherein the inserted character

string is added to image information which is to be sent to a destination (figures 2 and 3).

Although Microsoft Word 2000 discloses the inserted character string being added to text information which is to be sent to a destination ("It would have been obvious" is sent to a destination (display of figure 3), they do not explicitly mention about the inserted character string being added to an image information which is to be sent to the destination. However, it is well known in the state of the art that the text information of Microsoft Word 2000 is implemented in the text information. **The Examiner takes OFFICIAL NOTICE.** It would have been obvious to one of ordinary skill in the art, having the teachings of Microsoft Word before him, the text information of Microsoft Word to be the image information in order for display other information such as pictures, photographs than text information, as made known in the state of the art.

As to claims 2 and 21, Microsoft Word 2000 also discloses the selection of the character string is achieved *by* an instruction which designates a position in a region of the display screen in which the character string to be selected is displayed (figure 1a, when user double click "~", it is displayed in the box "replace-with").

As to claims 6 and 25 Microsoft Word also shows the plurality of character strings have been registered through an operation performed by the user (figure 1).

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As to claims 9,10, 28 and 29, Microsoft Word discloses the selected character string is input to a display screen which is displayed to enable entry of a character string designating a destination to which information is to be sent (figures 2 and 3, the selected character string (It would have been....) is input to a display screen by copy and paste the character string into the screen).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, 7, 8, 11-15, 22-24, 26-27, 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Word in view of Salm [US. 5,991,396].

As to claims 3, 4, 22 and 23, the modified Microsoft Word 2000 does not teach soft keyboard. However, Salm et al. shows the limitation at column 5, lines 47-54. It would have been obvious to one of ordinary skill in the art, having the teachings of Microsoft Word 2000 and Salm et al. before them at the time the invention was made to modify the display screen of modified Microsoft Word to include the soft keyboard as taught by Salm et al. in order to enhance the user friendliness by saving time when entering the use's input as taught by Salm et al.

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As to claims 5 and 24, Salm et al. shows the list including the registered character strings is displayed in place of the soft keyboard display screen, in response to said instruction (column 5, lines 33 through column 6, lines 16).

As to claims 7 and 26, Salm et al. demonstrates the selected character string is input to a display screen which is displayed to enable entry of a character string to be added to image information (column 7, lines 48 through column 8, lines 16).

As to claim 8, Salm et al. also demonstrates the list including the registered character strings is displayed on a display screen which is displayed to enable entry of a character string to be added to image information (column 8, lines 1-28).

As to claims 11 and 30, Salm et al. also discloses the at-a-glance display of the registered character strings is displayed on an operation panel of a copying machine (column 9, lines 18-39).

As to claims 12 and 31, Salm et al. teaches the selected character string is output by means of a printer (column 9, lines 61 through column 10, lines 12).

As to claims 13 and 32, Salm et al. also teaches instruction is given through a touch panel (column 5, lines 17-54).

As to claims 14 and 33, Salm et al. shows the instruction is given through a digitizer (column 8, lines 29-67).

As to claims 15 and 34, Salm et al. also shows the instruction is given through a coordinate input device (column 2, lines 65 through column 3, lines 19).

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As to claim 27, Salm et al. also demonstrates the displaying means displays on a display screen to enable entry of a character string to be added to image information (column 7, lines 48 through column 8, lines 16).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-18, 35-37, 39-40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Word 2000 in view of Ohkado [US. 5,717,426].

As to claim 16, the claim is analyzed as previously discussed with respect to claim 1 except for receiving an editorial instruction indicating an editing operation to be effected on the selected character string; effecting the editing operation on the selected character string in accordance with the editorial instruction on the selected character string; and updating the registered character strings in accordance with the result of the editing operation. Ohkado shows receiving an editorial instruction indicating an editorial work to be effected on the selected character string (see abstract), effecting the editorial work in accordance with the editorial instruction on the selected character string

(column 4, lines 45 through column 5, lines 7) and updating the registered character strings in accordance with the result of the editorial work (column 5, lines 24-58). It would have been obvious to one of ordinary skill in the art, having the teachings of Microsoft Word 2000 and Ohkado before them at the time the invention was made to modify the display and selected character string taught by Microsoft Word to include the editorial instruction of Ohkado, in order to help the user having a desired character string as taught by Ohkado.

As to claims 17, 18, 36 and 37, Ohkado also shows the editorial instruction is to add or delete a character (column 9, lines 10-46).

As to claim 35, the claim is analyzed as previously discuss with respect to claims 1 and 16, except for inputting means for enabling input of an editorial instruction indicating an editorial work to be effected on the selected character string. Salm et al. shows the inputting means on column 5, lines 42-53.

As to claims 39 and 40, Ohkado discloses update performed by said updating means includes addition (and deletion) of a character string (column 9, lines 10-46).

As to claim 42, the claim is analyzed as previously discuss with respect to claim 1 and 16.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious

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at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Word 2000 in view of Ohkado [US. 5,717,426] and further in view of Sam [US. 5,991,396] .

As to claims 19 and 38, the modified Microsoft Word 2000 and Ohkado do not teach the soft keyboard. However, Sam et al. teach the feature at column 5, lines 47-54. It would have been obvious to one of ordinary skill in the art, having the teachings of Microsoft Word 2000, Ohkado and Sam et al. before them at the time the invention was made to modify display screen of modified Microsoft Word to include the soft keyboard as taught by Salm et al. in order to enhance the user friendliness by saving time when entering the use's input as taught by Salm et al.

Response to Arguments

Regarding claims 1, 20, 41 and 43, Applicant has argued that Microsoft Word 2000 Screen Dumps does not teach "user selecting, based on a user instruction, one of the character string included in the list displayed in said step displaying step; and inserting the character string selected in said selecting step at a position pointed by a cursor being displayed on the display screen when the character string has been selected in the selecting step (figures 2 and 3). However, figure 1a of the Screen Dumps discloses one of the character string "It would have been obvious to an artisan at the time" from the list of character strings (figure 1), and the string is displayed in the box of "Replace-With". Then,

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the Screen Dumps shows the step of inserting the character string ("It would have been..." to be displayed on the display screen at a position pointed by using the cut and paste operations at figures 2-3. User cuts the string "It would have been obvious to an artisan at the time" and then pastes it into the display screen at cursor place (figure 3). Therefore, Microsoft Word itself teaches all the features of claims 1, 20, 41 and 43. Therefore, although, the list of registered character string is not displayed on the display in order for the user to be able to select one of the strings to be inserted, the registered character string still display on the display where at the position pointed by the cursor by using the cut and paste operations.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires fax a response, (703) 746-7238, may be used for formal After Final communications, (703) 746-7239 for Official communications, or (703) 746-4395 for Non-Official or draft communications. NOTE, A Request for Continuation (Rule 60 or 62) cannot be faxed.

Please label "PROPOSED" or "DRAFT" for information facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Fourth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mylinh Tran whose telephone number is (703) 308-1304. The examiner can normally be reached on Monday-Thursday from 8.00AM to 6.30PM

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-05186,

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the

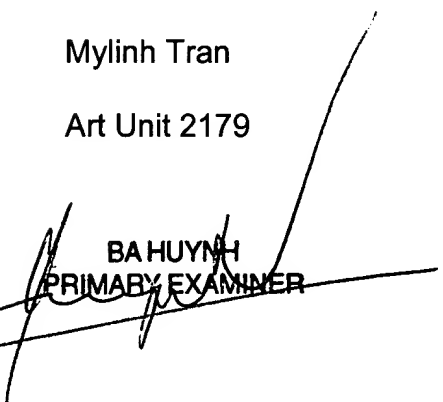
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confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Mylinh Tran

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BA HUYNH
PRIMARY EXAMINER